

REMARKS

I. INTRODUCTION

In response to the pending Office Action, Applicants respectfully request reconsideration of the pending rejection of claims 9, 21 and 25 for the following reasons.

Applicants note with appreciation the indication of allowance of claims 1, 3, 6-8, 18-20, 22-24, 26 and 27.

II. THE REJECTION OF THE CLAIM 9 UNDER 35 U.S.C. § 103

Claim 9 was rejected under 35 U.S.C. § 103 as being obvious over USP No. 6,262,785 to Ikeda, in view of USP No. 6,271,060 to Zandman. For the following reasons, it is respectfully submitted that claim 9 is patentable over the cited prior art.

As noted in Applicants' previous response, claim 9 recites that the coating of a *conductive adhesive* disposed on the external electrode contains a conductive filler, and more importantly, that the coating is disposed on the *entire surface* of the external electrode (as shown, for example, in Figs. 1 and 2 of the present invention). As a result of the structure of the claimed device, it is possible minimize alignment problems/issues when mounting the device to, for example, a circuit board. More specifically, because *the conductive adhesive is applied to the entire surface of the external electrode*, the orientation of the device (about the longitudinal axis thereof) when it is placed in contact with the connecting terminals disposed on, for example, the circuit board becomes irrelevant.

Turning to the pending rejection, it is asserted that the combination of Ikeda and Zandman renders claim 9 obvious. However, for the following reasons, Applicants respectfully submit that the combination of Ikeda and Zandman is improper.

First, it is noted that the pending rejection admits that Ikeda fails to disclose the conductive adhesive disposed over the entire surface of the electrode. Zandman is relied upon as curing the deficiencies of Ikeda. However, this combination of prior art is improper because Ikeda teaches away from the modification utilized to reject the pending claims.

More specifically, as set forth in col. 1, lines 5-25 of Ikeda, Ikeda describes the use of solder to mount electronic parts to a substrate as a prior art technique. Ikeda then proceeds to state that the use of solder causes problems. As such, Ikeda teaches away from the use of solder. However, the disclosure of Zandman relied upon by the Examiner states that layer 216, which is disposed on the electrode 215, is formed of solder. Specifically, as stated in Zandman “[f]or example, metal layer 216 can be a one mil thick layer of solderable metal such as tin/lead” (see, col. 6, lines 66-67). Thus, Zandman teaches that a solder layer 216 is disposed over metal layer 215. Accordingly, if Ikeda was modified to practice the disclosure of Zandman, the intended purpose of Ikeda would be destroyed, as Ikeda teaches away from the use of a solder in contact with the electrode.

It is well known that references cannot be combined where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731 (Fed. Cir. 1983), see also, M.P.E.P. § 2145.X.D.2. It is also known that the references cannot be combined if the combination would render the modified reference unsuitable for its intended purpose. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). Clearly, both of the foregoing principles apply in the instant case as Ikeda teaches away from the use of solder. Thus, the combination of Ikeda and Zandman is improper, and cannot be properly relied upon to reject claim 9.

Secondly, there is also no motivation or suggestion to make the proposed modification of Ikeda in view of Zandman without reference to the Applicants' specification, which is clearly

impermissible. More specifically, the electrode of Zandman relied upon in the pending rejection serves the purpose of connecting the gate electrode 202, which is located on the back of the device, to the front of the device such that it is available for contact on the same surface as the gate and source electrodes. Thus, as with Ikeda, **the orientation of the device of Zandman when being mounted is relevant**. In other words, the device of Zandman must have a specific orientation when placed in contact with a substrate.

In contrast, in accordance with the present invention, because *the conductive adhesive is applied to the entire surface of the external electrode*, the orientation of the device (about the longitudinal axis) when it is placed in contact with the connecting terminals disposed on, for example, the circuit board becomes irrelevant. Neither Ikeda nor Zandman suggest that it would be desirable to form a device wherein the orientation of the device when it is placed in contact with the connecting terminals disposed on, for example, the circuit board becomes irrelevant. Thus, there is no motivation to combine the references in the manner set forth in the Office Action, and therefore for this additional reason the rejection is improper.

The Examiner is also directed to MPEP § 2143.01 under the subsection entitled “Fact that the Claimed Invention is Within the Capabilities of One of Ordinary Skill in the Art is Not Sufficient by Itself to Establish *Prima Facie* Obviousness”, which sets forth the applicable standard:

A statement that modifications of the prior art to meet the claimed invention would have been [obvious] because the references relied upon teach that all aspects of the claimed invention were *individually* known in the art is *not* sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. (citing *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)).

In the instant case, even assuming *arguendo* that the combination of the patents “teach that all aspects of the claimed invention [are] individually known in the art”, it is submitted that

such a conclusion “is not sufficient to establish a *prima facie* case of obviousness” because there is no *objective* reason on the record to combine the teachings of the cited prior art.

For all of the foregoing reasons, it is respectfully submitted that claim 9 is patentable over Ikeda and Zandman taken alone or in combination with one another.

III. ALL DEPENDENT CLAIMS ARE ALLOWABLE BECAUSE THE INDEPENDENT CLAIMS FROM WHICH THEY DEPEND ARE ALLOWABLE

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claim 9 is patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also in condition for allowance.

IV. REQUEST FOR NOTICE OF ALLOWANCE

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited.

If there are any outstanding issues that might be resolved by an interview or an Examiner’s amendment, the Examiner is requested to call Applicants’ attorney at the telephone number shown below.

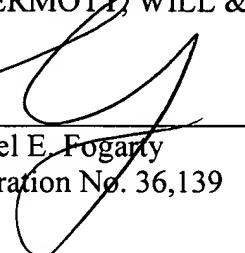
To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY

Date: 3/29/04

By:


Michael E. Fogarty
Registration No. 36,139

600 13th Street, N.W., Suite 1200
Washington, DC 20005-3096
(202)756-8000 MEF:rp:men
Facsimile: (202)756-8087
WDC99 881111-1.056937.0022